

REMARKS

Claims 1-61 are pending in this application with Claims 1 and 49 amended. The Applicant respectfully requests reconsideration and review of the application in view of the foregoing amendments, the Declaration of Anthony Rothschild (filed herewith) and the following remarks.

The Examiner objected to the specification for including an embedded hyperlink and/or other form of browser-executable code and suggested that the Applicant delete the URLs and email links on page 10, line 26, page 13, line 17, and page 16, line 4. The Applicant believes, however, that it is necessary to include these links (and not the contents of the sites to which the links are directed) in the specification to comply with the requirements of 35 U.S.C. § 112, first paragraph, and that it was not intended for these links to be active. Therefore, in accordance with MPEP § 608.01(VII), the Applicant respectfully requests that these links be disabled when preparing the text to be loaded onto the USPTO web database, and that this objection be withdrawn.

The Examiner further objected to Claim 1, line 15 for including a typographical error (i.e., “additional advertisement” should be “additional communication data”). The Applicant has amended Claim 1 as suggested. Therefore, the Applicant respectfully requests that this objection be withdrawn

The Examiner rejected Claims 9-11 and 25 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. These rejections are respectfully traversed.

As for Claims 9-11, the Examiner stated that “[i]t is not clear what a ‘populated communication page’ is, nor how it is used to provide the described effects such as extraction of recipient and advertisement by the application.” An exemplary “communication page” is shown in Figure 4. A person can use such a page to send a personal communication and an advertisement to another by “populating” (or entering information into) the page. The populated information includes, for example, the actual

communication, the recipient of the communication, the subject of the communication, an advertisement to be attached, etc. This information is then used by the advertising application to generate and send a personal communication (e.g., as shown in Figure 3). This is done by extracting relevant information from the populated communication page (e.g., recipient, advertisement, etc.) and using that information to generate a personal communication. If the recipient interacts with the advertisement, additional communication data, which may be provided by a third party (Claim 12) or the sender (Claim 9), is transmitted to the recipient.

Claim 10 defines a specific embodiment of the present invention where the personal communication is not sent to the recipient, but instead advertised to the recipient. For example, the populated communication page may be used to generate a personal communication that is advertised to the recipient. If the recipient interacts with the advertisement, the recipient is then provided with the personal communication. In this embodiment, the personal communication acts as the additional communication data. Because the features of Claims 9-11 are sufficiently disclosed in the specification (see, e.g., Figures 3, 4; col. 14, line 21 – col. 17, line 7), it is respectfully requested that this rejection be withdrawn.

As for Claim 25, the Examiner stated “[i]t is unclear how the application can identify the recipient device for the original incoming personal communication and advertisement.” This is described, for example, in Figure 7, col. 18, line 18 – col. 19, line 4, and col. 20, line 24 – col. 21, line 17. By way of example, when a recipient checks for new email (e.g., by logging into a web-based email server, etc.), the request, or more particularly the HTTP protocol used in the request, which includes device identifying information, is used to identify the type of device. See, e.g., col. 20, line 24 – col. 21, line 17. The personal communication and the advertisement are then formatted accordingly. Because the features of Claim 25 are sufficiently disclosed in the specification, it is respectfully requested that this rejection be withdrawn.

The Examiner further rejected Claims 49-61 under 35 U.S.C. § 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "said additional communication data" in Claim 49, from which Claims 50-61 depend, lacks antecedent basis. The Applicant has amended Claim 49 so that this term now includes proper antecedent basis. Therefore, the Applicant respectfully requests that this rejection be withdrawn.

Before addressing the merits of the rejections based on prior art, a brief description of the present application is provided. The present invention is directed toward a system and method of using a sender of a personal communication (e.g., an email, etc.) to select (or initiate the selection of) an advertisement and using the personal communication to deliver the advertisement to at least one recipient. For example, in one embodiment of the present invention, an advertising application is adapted to allow a sender of an email to add an advertisement to the email. See, e.g., col. 13, line 16 – col. 14, line 10; Figure 3. The email (including the advertisement) is then sent to a recipient. In exchange for including the advertisement in the email, the sender may be compensated (e.g., receive a benefit, be paid, etc.). See, e.g., col. 17, lines 8-20. Such a system is advantageous over the prior art in that it allows the advertisement to be targeted (or personalized) for the recipient of the email, and is therefore more likely to be viewed positively and/or interacted with.

The Examiner rejected Claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach, Jr. et al. (U.S. Pat. No. 6,449,657) in view of Joo et al. (Korean Pat. App. No. 99073076) and Camut et al. (U.S. Pat. No. 6,684,257). The Examiner further rejected Claims 2-4, 41, 45-47, 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Joo, Camut and Bayeh et al. (U.S. Pat. No. 6,012,098). The Examiner also rejected Claims 23, 24 and 60 under 35 U.S.C. 103(a) as being unpatentable over Stanbach in view of Joo, Camut and Rakavy et al. (U.S. Pat. No. 6,317,789). These rejections are respectfully traversed.

The primary (and common) references relied upon by the Examiner are

Stanbach, Joo and Camut. These references, however, are ***not prior art references***, and therefore ***cannot serve as a basis for a prior art rejection***. The Stanbach, Joo and Camut references bear dates (i.e., filing or publication dates, collectively referred to herein as "effective cited reference dates") that are only a couple of months earlier than the date the present application was filed (i.e., January 6, 2000). Anthony Rothschild, the inventor of the present invention, conceived of the present invention prior to the effective cited reference dates and was reasonably diligent in reducing his invention to practice. This is supported, for example, by the Declaration of Mr. Rothschild ("Rothschild Decl."), including the exhibits that are attached thereto. A declaration from Mr. Rothschild is being submitted herewith for consideration pursuant to 37 C.F.R. § 1.131.

According to this declaration, Mr. Rothschild disclosed his invention to Jean Paul Schmetz, CEO of Cyber Lab, in April of 1999. Rothschild Decl., ¶¶ 4-10. This is evidenced by the Non-Disclosure Agreement (NDA) signed by Messrs Rothschild and Schmetz in April 1999 (Exhibit A), the draft proposal from Cyber Lab in May 1999 (Exhibit B), and the detailed proposal from Cyber Lab in August 1999 (Exhibit D). Features that are asserted by the Examiner as being disclosed in the prior art are explicitly discussed in these communications.

For example, independent Claims 1, 31 and 49 are directed toward a system and method of allowing a sender of a personal communication (e.g., an email) to add an advertisement to the personal communication, which then gets sent to at least one recipient. In rejecting these claims, the Examiner cited Stanbach and Joo for their disclosure of this same. This claimed feature, however, was previously discussed in the communications with Cyber Lab. For example, in Cyber Lab's draft proposal, the present invention was described as "an advertisement system that would ... [a]llow users to register to the system and select which advertisements they would like to include in their emails." Rothschild Decl., ¶ 7; Exhibit B. This feature was also discussed in Cyber Lab's detailed proposal. See, e.g., Rothschild Decl., ¶ 10; Exhibit D,

Section 3.1 ("@mail recruits companies (A) and their range of trademarks, products advertisements etc. which will be put to a private person's disposal. Person (B) attaches a chosen advertisement to his email.").

This feature was also discussed in a July 20, 1999 letter from Mr. Rothschild to Christopher Mackenzie, an associate of the private equity investment firm of Clayton, Dublelier & Rice and acquaintance of Martin Sorrel, CEO of WPP, one of the largest advertising agencies in the world. Rothschild Decl., ¶ 9; Exhibit C. Therein it is stated that "[t]he sender can add either automatically or through manual selection advertising material to the body, top or end of their message or as an attachment to the email." Id.

A cursory review of Mr. Rothschild's Declaration and the exhibits attached thereto show that Mr. Rothschild conceived of the present invention prior to the effective prior art dates and was reasonably diligent in reducing his invention to practice. Thus, the Stanback reference (filed August 6, 1999), the Joo reference (published October 5, 1999) and the Camut reference (filed October 15, 1999) are not prior art to the present application and cannot be used as a basis for a rejection. Therefore, the Applicant respectfully requests that the present rejections, all of which are based on a combination of at least Stanback, Joo and Camut, be withdrawn.

In view of the foregoing, the Applicant respectfully submits that Claims 1-61 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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To the extent necessary, Applicant petitions the Commissioner for a three-month extension of time, extending to January 6, 2005, the period for response to the Office Action dated July 6, 2004. Pursuant to 37 C.F.R. § 1.17(a)(3), a check in the amount of \$510 is enclosed for the Petition for Extension of Time. The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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Jonathan A. Jaech  
Attorney for Applicant  
Registration No. 41,091

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**O'MELVENY & MYERS LLP**  
400 South Hope Street  
Los Angeles, CA 90071-2899  
Telephone: (213) 430-6000